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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,963	02/07/2002	Yoshio Saito	02072/LH	1518

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,963

Applicant(s)

SAITO ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a decorative sheet, classified in class 428, subclass 195.
 - II. Claims 7-10, drawn to method of producing a decorative sheet, classified in class 427, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the sheet of I can be made by supplying base film between rolls prior to forming a print pattern layer.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Leonard Holtz on 5/19/03 a provisional election was made without traverse to prosecute the invention of I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-10 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 875 374 A2 to Shimizu in view of USPN 6,326,086 to Mori et al.

8. Shimizu teaches a decorative laminated sheet comprising a layer of completely amorphous polyester type resin (includes 100% amorphous polyester, meeting instant claim 6) and a substrate layer of amorphous polyethylene terephthalate (APET) see Example 1, page 3, lines 35-55, page 4, lines 1-20 and Abstract. Shimizu teaches an APET can be partially crystalline at page 2, lines 15-25. The thermoplastic may be colored or surface-printed at page 2, lines 22-23. This teaching is equivalent to a base material of colored APET as a main component. Shimizu teaches a transfer foil may be applied over the APET, and that the foil may also be comprised of APET (see page 2, lines 45-55), hence equivalent to "transparent layer". A

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print layer for a design may be applied to the transfer foil, which Shimizu states can be made of the APET, thereby functioning as a suitable layer adjacent to a base material of APET, although Shimizu does not state the layering in the same manner. Further at page 4, lines 10-15, Shimizu teaches a transparent protective film for protecting the print layer and a top coat layer are known in the art and teaches applying adhesive to APET. Shimizu teaches corona treatment can be applied to APET at page 4, lines 1-5, and further laminated via adhesive and explains corona discharging APET and/or transfer foil (which inherently provides the "hard" property) laminated with adhesive (equivalent to "surface protective layer) in Example 2, hence meeting instant claims 2-5.

9. While Shimizu teaches polyvinyl chloride resins may be blended with APET at page 3, line 11, Shimizu does not teach the ink composition of the pattern layer. However, Mori teaches a sheet for molded in foil decoration and method by using the sheet comprising wood grain ink of vinyl chloride suitable to apply to an APET film. See col. 10, lines 50-55 and col. 12, lines 27-55 and Example 3 to color for automotive console panels. Hence, it would have been obvious to one of ordinary skill in the art to modify the sheet of Shimizu to include the ink composition including vinyl chloride for the purpose of providing decoration, especially for wood-grained appearance for automotive console panels as taught by Mori in Example 3.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- USPN 5,114,789 to Reafler teaches a protective and decorative sheet with a transparent top coat.
- USPN 5,763,048 to Takahashi teaches a matte decorative sheet having scratch resistance.
- USPN 6,364,992 to Nambu et al. teaches a decorative sheet and process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus
Examiner
Art Unit 1774

June 24, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

